

Appl. No. 09/721,462  
Amdt. dated January 25, 2006  
Reply to Office Action of 10/26/05

PATENT

**REMARKS/ARGUMENTS**

Claims 1-25 are pending in the application. Claims 1-25 were examined and are rejected.

**Rejections under 35 USC § 102**

Claims 13, 15, 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Haertl (U.S. Patent 4,987,597).

Applicants respectfully traverse this rejection in that Haertl fails to teach several limitations of the claimed invention. Haertl is "directed to an apparatus for closing an opening of a hearing aid or an ear adaptor for a hearing aid" (Haertl, Col 1, lines 7-10; See also the Abstract) and not to an "intracanal shield shaped and dimensioned to be laterally positioned with respect to said hearing device, so that said intracanal shield caps the cavity of said ear canal" as is recited in independent claim 13 (emphasis added). Haertl's cap can not cap the cavity of the ear canal because its cap must be sized to cap an opening of a hearing aid (either a sound entrance opening 11, and/or the sound exit nozzle 2) that is inserted into the ear canal. (See Haertl Col 3, lines 1-10). No where does Haertl teach that its cap is intended to cap "the cavity of the ear canal", nor can it since to perform Haertl's intended purpose of capping an opening on an "in-the-ear hearing aid" (See Haertl Col 2, lines 58-60) the perimeter of Haertl's cap is necessarily much smaller than the perimeter of the ear canal. In other words, Haertl's cap can't be sized and dimensioned to fit in two places at once and still perform its intended function of capping an opening on a hearing aid.

Haertl is also deficient with regard to another structural limitation of claim 13. In particular, no where does Haertl teach or suggest "a conforming perimeter for fitting in a retaining manner along the cross sectional wall of the ear canal" as is recited in claim 13. Nor can it since, as described above, Haertl's cap is intended to fit over and cap an opening on an in-the-ear hearing aid and not to be retained in the ear canal so as to cap the cavity of the ear canal. These two functions are in effect, mutually exclusive given the small size of the opening on the Haertl's hearing aid in relation to the perimeter of the ear canal. Haertl further teaches away from a conformable perimeter in that Haertl teaches that its cap is sufficiently rigid to screw or

Appl. No. 09/721,462  
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PATENT

snap onto an opening of the hearing aid. See Haertl, Col 3, lines 5-10. Thus, Haertl fails to teach not one, but two limitations of the invention of independent claim 13 and dependant claims 15, 16-18. Accordingly, withdrawal of the rejection is respectfully requested.

Rejections under 35 USC § 103

For the Examiner's convenience Applicants have numbered the rejections to correspond to the paragraph numbering in the 10/26/05 Office Action.

5) Claims 1, 3, 4-6 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl (U.S. Patent 4,987,597) in view of Finlayson (U.S. Patent 6,145,226).

6) Claim 2 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl in view of Finlayson in further view of Flagler (U.S. Patent 6,134,333).

7) Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl (in view of Finlayson further view of Steer (U.S. Patent 5,352,316).

8) Claims 8, 9, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl in view of Finlayson in further view of Brown et al. (U.S. Patent 6,129,174).

9) Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl in view of Finlayson (in further view of Oliveira (U.S. Patent 5,401,920).

10) Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl (in view of Flagler (U.S. Patent 6,134,333)

10) Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl in view of Flagler in further view of Leedom (U.S. Patent 5,825,896).

11) Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl in view of Steer (U.S. Patent 5,352,316).

12) Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl in view of Oliveira (U.S. Patent 5,401,920).

Appl. No. 09/721,462  
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13) Claims 20, 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Haertl) in view of Brown et al. (U.S. Patent 6,129,174).

Applicants respectfully traverse all of the above rejections as none of the cited art alone or in combination teaches or reasonably suggests multiple elements of the claimed invention of independent claims 1, 13 and 25 and therefore their respective dependant claims. Applicants will address the bulk of these rejections by addressing the rejection in paragraph 5.

In regard to the rejection in paragraph 5, no where does Haertl teach or suggest an "intracanal shield for positioning entirely in the ear canal and capping the cavity of said ear canal" as is recited in independent claim 1 or a cap "shaped and dimensioned to be positioned entirely in the ear canal for extended wear therein to protect a medially positioned hearing device within the ear canal" as is recited in independent claim 25. Further, for reasons stated above, Haertl teaches away from such limitations and in particular, teaches away from "a conforming perimeter adapted to fit in a retaining manner along the cross sectional wall of the ear canal cavity" as is recited in claim 1. Moreover, even if this were not the case, none of the other cited references compensates for Haertl's lack of "a conforming perimeter." Therefore, none of the cited references, alone or in combination, teach or suggest all elements of any of claims 1, 3, 4-6 and 25. Accordingly, on this basis alone, withdrawal of the rejection is respectfully requested.

Moreover, as Applicants have stated in the response of 4/13/05, no where does Haertl teach or suggest an intra canal shield or cap with "pores sized for allowing air to pass through said porous member to provide a circulated air flow in the ear canal sufficient to reduce an incidence of canal infection." as is recited in claims 1 and 25. There is no teaching in Haertl of specific pore sizes, let alone pores sized to provide a circulated air flow in the ear canal sufficient to reduce an incidence of canal infection.

While, the Examiner appears to rely on Finlayson to correct for the deficiency of Haertl with respect to pore size and air circulation in the ear canal, such reliance is misplaced in two important respects. First, Finalyson is directed to an ear tag assembly for attachment to the external ear of an animal, and not to a device that is placed in the ear. See, Finalyson, Abstract.

Appl. No. 09/721,462  
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Since the tag of Finalyson is never placed in the ear it never considers the problem of infection within the capped ear canal. Clearly therefore, it can not teach a solution.

Second, the air circulation that Finalyson mentions is entirely outside of the ear (e.g., around a narrowed backing component 15 of a pin 16 used to attach the tag to the ear; See, Finalyson, Col 5, lines 12-24). In essence, Finalyson teaches the design of an earring which has a smaller backing to allow for circulation around the pin of the earring. Such a design provides no teaching of air circulation within the ear canal to prevent infection, let alone air circulation through a porous membrane placed within the ear canal. In fact, Finalyson does not even teach the use of a single porous component for its ear tag. Thus, Finalyson can not and does not provide any teaching of the pore sizes of any material, let alone the pore sizes a porous cap for achieving air circulation in the ear canal sufficient to reduce infection. Accordingly, since Finalyson fails to correct for the deficiencies of Haertl with respect to pore size, withdrawal of the rejection of claims 1, 3, 4-6 and 25 is respectfully requested on this separate and additional basis.

In regard to the rejection detailed in paragraphs 6-13 of the Office action, these are traversed in that: 1) none of the remaining cited references compensates for the deficiencies of Haertl described above; and 2) as described above, Haertl teaches away from the claimed invention in multiple respects and the courts have held that an obviousness rejection is improper when the combination of references teaches away from the claimed invention (See In re Gurley, 27 F.3d 551, 553, 31 (Fed. Cir. 1994). Accordingly, withdrawal of these rejections is respectfully requested.

CONCLUSION

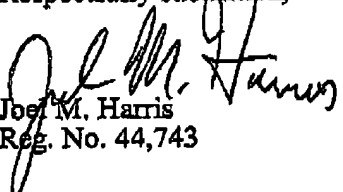
In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

Appl. No. 09/721,462  
Amdt. dated January 25, 2006  
Reply to Office Action of 10/26/05

PATENT

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-326-2400.

Respectfully submitted,

  
Joel M. Harris  
Reg. No. 44,743

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 650-326-2400  
Fax: 415-576-0300  
Attachments  
J7H:snb  
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